**Remarks**

Claims 17 to 32 are pending in the application, and have not been amended.

In the Office Action dated October 25, 2011, claims 17 to 34 are now rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application Publication No. 2003/0040323 (Pihl) in view of U.S. Patent Application Publication No. 2002/0168989 (Dooley). Reconsideration is requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 17 to 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2003/0040323 (Pihl) in view of US 2002/0168989 (Dooley). It is respectfully submitted that the obviousness rejection is in error.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 381 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as the Supreme Court has held, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in a manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q. 2d 1385 (2007).

Here, it is respectfully submitted that even if the teachings of Pihl and Dooley were to be hypothetically combined, the hypothetical combination would not have led to the claimed subject matter. For the Patent and Trademark Office to combine references in an obviousness rejection, the Patent and Trademark Office must identify a reason why a person of ordinary skill in the art would have combined the references. *Ibid.* If the Patent and Trademark Office cannot establish obviousness, the claims are allowable.

In this case, the Patent and Trademark Office has failed to show where each and every limitation of the claims is taught or suggested by the prior art.

As recognized by the Office Action, Pihl fails to disclose

> "a first base station that communicates wirelessly according to a first protocol and a second base station that communicates wirelessly according to a second protocol different from the first protocol" (office action last third of page 3).

However, the Office Action relied on Dooley to

> "disclose a method and process of locating a multi-mode wireless terminal where the wireless terminal is adapted to take position measurements on a first network (GSN) and then take measurements on a second network (UMTS), and then the measurements are combined and the position of the terminal is determined" (office action page 3, last five lines).

As has been elaborated in the Pre-Appeal Brief Request when filing it on July 7, 2011, Pihl does not disclose the interoperation of two base stations that communicate wirelessly according to respectively first and second protocols.

The combination of Pihl and Dooley also does not teach such an interoperation for the following reasons:

The Office Action has failed to show that the combination of Pihl and Dooley discloses the following features of claim 17 of the instant patent application:

1) The first base station is sending a location request to the mobile terminal.
2) The request specifies that the position of the mobile terminal is to be based on measurements made with respect to information from a second base station.

3) The first base station receives from the mobile terminal the measurements made with respect to the information from the second base station.

4) The base station performing an action to cause processing of the received measurements to determine the position of the mobile terminal.

Dooley simply discloses an autonomous determination of the location of a mobile terminal by the terminal itself.

As far as the result of this location determination is concerned, it serves a purpose to locate a mobile terminal and to give the user of the mobile terminal an indication of the current position. The determination does not take place as a consequence of a request and is not delivered and not evaluated outside the mobile terminal.

According to Dooley,

> "the results are passed to a controller 22 which controls the operation of the terminal in accordance with pre-stored software. An LCD screen 24 is coupled to the controller 22 and may be used to display the position of the terminal MWT." (para. [0021], last six lines).

Dooley gives the skilled person no teaching at hand to communicate the results of the location determination outside of the mobile wireless terminal. Pihl, on the other hand, only teaches that measurement data can be processed and are based on measurements taking place in a single communication environment, even though operated by different operators. Thus, none of the prior art teaches a combination of measurement data taken from different communication networks, based on a first and a second communication protocol to determine the location based on a request from a client.

Consequently there is no teaching in the combined prior art how to evaluate location data from a first communication environment in a second communication environment and vice versa.

Pihl does not teach **feature 1)** of claim 17 (identified above) for the following reasons:

Pihl teaches not to forward a request to the mobile terminal. Namely, Pihl teaches that

> "the SMLC provides a target mobile station with an E-OTD assistance data message regarding base stations linking to the SMLC, at step 112. The mobile station measures BCCH frequency of the base stations identified by the SMLC at step 114." (para. [0038], lines 4 to 8).

Consequently, Pihl does not teach forwarding of a request, but instead of the request, sending E-OTD assistance data. These E-OTD assistance data form the basis for measurements performed by the mobile terminal. For all that matters, the mobile terminal is not aware what the purpose of these measurements is.

Moreover, Pihl does clearly not teach **feature 3)** of claim 17 of the instant patent application, because Pihl does not teach location determination in two different networks based on wireless communication using a first and a second protocol. Thus, Pihl surely does not teach that the base station receives from a mobile terminal the measurements made with respect to information from the second base station (using a different communication protocol than the first base station).

Moreover, clearly Pihl does not teach **feature 4)** of claim 17 of the instant patent application, i.e.

> "the first base station performing an action to cause processing of the received measurements to determine the position of the mobile terminal".

The combination of Pihl and Dooley misses a major concept of the instant application, namely that a first network (using a first communication protocol) for wireless communication via the base station needs to be capable of processing measurement data that is received from a different communication network, where the base station communicates wirelessly based on a second communication protocol and location determination is taking place in a different manner. Whereas 2G-systems use E-OTD assistance data, 3G-systems use OTDOA-IPDL where

measurements of reception time difference are made by the UE20 from several nodes B (observed time difference of variable-idle period downlink).
The instant invention teaches

> "when the first subsystem is capable of processing the measurements carried out on the second subsystem by the mobile terminal, it takes them into account, in a beneficial manner, in its position-finding algorithm" (page 6, fifth paragraph, lines 1 to 3).
>
> "However, when the first subsystem is not itself capable of processing the measurements carried out on the second subsystem by the mobile terminal, it transmits said measurements to the second subsystem, in the beneficial manner, so that they may be processed thereat according to an appropriate position finding method" (page 6, para. 6, lines 1 to 4).

However, the combination of Pihl and Dooley does not teach the skilled person that there is a problem with the processing of measurement data received from a different communication system (where a wireless communication is based on a second communication protocol).

Further, the combination of Pihl and Dooley does not present any solution as to how a base station that communicates with a first communication protocol wirelessly may handle data received from a mobile device that have been measured in relation to a base station that communicates wirelessly over a second communication protocol.

Thus, as demonstrated above, the combination of Pihl and Dooley does not teach **features 1) to 4)** of claim 17 of the instant patent application. Consequently, these features are not rendered obvious for the skilled person by the combination of the teachings of Pihl and Dooley.

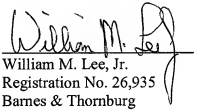
Thus, it is respectfully submitted that claim 17 is allowable. This also holds true for the other independent claims 23, 29 and 32, directed to other systems and methods comprising corresponding features to the ones discussed above.

It is therefore respectfully requested that the § 103 rejection regarding claims 17, 23, 29 and 32 be withdrawn. The same applies to dependent claims 18 to 22, 24, 28, 30 to 31 and 33 to 34 which are submitted to be allowable at least by virtue of being dependent on an allowable independent claim.

The Examiner's further and favorable reconsideration of this application is therefore urged.

Januar 25, 2012

Respectfully submitted,



William M. Lee, Jr.
Registration No. 26,935
Barnes & Thornburg
P.O. Box 2786
Chicago, Illinois 60690-2786
(312) 214-4800
(312) 759-5646 (fax)

CHDS01 WLEE 735315v1